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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,523	11/21/2003	Martin Josso	016800-586	8425

21839 7590 05/12/2006

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ALEXANDRIA, VA 22313-1404

EXAMINER

ALSTRUM ACEVEDO, JAMES HENRY

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/717,523

Applicant(s)

JOSSO, MARTIN

Examiner

James H. Alstrum-Acevedo

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-27,29,30,32-55,57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-27, 29-30, 32-55, and 57-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/31/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 3-27, 29-30, 32-55, 57-58 are pending. Receipt of the remarks/arguments and amendments in the reply filed on February 16, 2006 is acknowledged. Claims 2, 28, 31 56, and 59 were cancelled by the Applicant in the reply filed on February 16, 2006.

Specification

The objection of the specification because of informalities including unnecessary accent marks in [0040] and [0063] **is withdrawn**, per the Applicant's amendments to said specification. The objection of the specification due to the improper use of trademarks is withdrawn, per Applicant's amendments to the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

The rejection of claims 1-10, 19-24, 3-39, and 47-52 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is withdrawn** per Applicant's amendments.

Upon reconsideration, the rejection of claims 12 and 41 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is maintained** per Applicant's amendments.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claims 1-6, 9-12, 14, 15, 25, 30, 31, and 40-41 under 35 U.S.C. 102(b) as being anticipated by Iijima (U.S. Patent No. 6,258,857) **is withdrawn**, per Applicant's amendments.

The rejection of claims 30-31, 40-41, and 43, and 45-46 under 35 U.S.C. 102(b) as being anticipated by Roman (U.S. Patent No. 6,171,602) **is withdrawn**, per Applicant's amendments.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The claims 32-39, 40-41, and 53 under 35 U.S.C. 103(a) as being unpatentable over Roman (U.S. Patent No. 6,171,602) **is withdrawn**, per Applicant's amendments.

The rejection of claims 3, 5, 7, 8, 11, 16-18, 28, 29, 40-41, and 43-44 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) **is withdrawn**, due to Applicant's amendments.

The rejection of claims 13, 42, 58, and 59 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) in view of Fankhauser et al. (US 2002/0155073) is **maintained**. Claims 1, 3-6, 9-12, 14-18, 25, 29-30, 32-41, 43-46, and 53 are additionally added

Art Unit: 1616

to this rejection, per the teachings/disclosures set forth on pages 5-6 and 10-11 of the previous office action.

Additional relevant teachings of Fankhauser not expressly cited in the previous office action are set forth below.

Fankhauser teaches that his invention can be used in the form of various cosmetic formulations, including for treating hair, such as shampoos, hair conditioners, hair care compositions, etc. [0248]. The cosmetic formulations taught by Fankhauser can be in one of various forms, including in the form of liquid preparation such as water in oil (W/O), oil-in-water (OIW), oil-water-oil (O/W/O), water-in-oil in water (WIO/W), PIT, and other microemulsions [0250]. It is also noted that Fankhauser teaches the inclusion of inorganic micropigments, including ZnO and TiO₂ coated with either aluminum oxide or silicon dioxide (i.e. silica) [0259]. Microemulsions are obvious over emulsions.

The rejection of claims 19-24 and 47-52 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) in view of Torgerson et al. (U.S. Patent No. 6,458,906) **is maintained**. Claims 1, 3-12, 14-18, 25, 29, 30, and 32-41 are additionally appended to this rejection, per the disclosures/teachings set forth on pages 5-6 and 11-13 of the previous office action.

Additional relevant teachings of Torgerson not expressly cited in the previous office action are set forth below.

Torgerson teaches topical skin care compositions wherein the carrier can be in a wide variety of forms, for example, emulsion carriers, including oil-in-water (O/W), water-in-oil

(W/O), and oil-in-water-in-silicone (O/W/S) emulsions (col. 15, lines 50-61). Preferred cosmetically and/or pharmaceutically acceptable topical carriers include hydro-alcoholic systems and oil-in-water emulsions (col. 16, lines 23-25).

The rejection of claims 26-27, 54-55, and 57 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) ("Iijima") in view of Torgerson et al. (U.S. Patent No. 6,458,906) ("Torgerson") as applied to claims 3, 5, 7, 8, 16-18, and 29 above, and further in view of Candau, D. (U.S. Patent No. 6,033,648) ("Candau") **is maintained**. Additionally, the claims added to the previously maintained rejection under 35 U.S.C. §103(a) over Iijima in view of Torgerson are also appended to this rejection, per the teachings set forth on pages 5-6 and 11-14 of the previous office action.

Additional relevant teachings of Candau not expressly cited in the previous office action are set forth below.

Candau teaches that his invented compositions can also comprise fillers, preferably spherical fillers having a size less than 25 microns, including silica microparticles (col. 10, lines 39-48). Furthermore, Candau teaches that his compositions can be provided in the form of creams, milks, gels, cream gels, ointments, fluid lotions, vaporizable fluid lotions, or any other form generally used in cosmetics, in particular those forms suitable for the artificial coloration of the skin. Candau's formulations may be formulated via techniques well known in the art, such as those suited for the preparation of water-in-oil emulsions (col. 11, lines 1-10). It is noted that milks and creams are understood to be emulsion formulations.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 4, 9-12, 14-17, 30, 32-33, 38-41, and 43-46 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6-15, 29, and 30 of copending Application No. 10/365,653 (copending ‘653). It is noted that although copending ‘653 does not have a common inventor with the instant application both applications are assigned to L’Oreal. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are overlapping in scope and mutually obvious. The cited claims of the instant invention are drawn to a composition and a device containing therein said composition intended for protecting the hair and/or skin from UV radiation, wherein said composition comprises a photoprotective system and spherical porous silica microparticles. The claims of copending ‘653 are drawn to topical compositions

Art Unit: 1616

intended to provide ultraviolet light protection (i.e. UV protection). It would have been obvious to a person of ordinary skill in the art that topical compositions are generally applied to the skin and that it is a conventional practice to place said compositions in a container or other device which may be used to apply the UV-protecting composition. Both applications commonly recite porous silica microparticles (i.e. silica particles having a particle size measured in tens of microns). Regarding the amount of silica particles in a given composition and the shape of said particles, the physical characteristics (e.g. size and shape) of particulate compositions and the amounts of ingredients of said compositions are clearly result specific parameters that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal physical particle characteristics (e.g. particle size, particle shape, etc.) of a particulate composition as well as the optimal amount of individual ingredients needed to achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, the optimization of ingredient amounts would have been obvious at the time of applicant's invention. Therefore, the Examiner concludes that 1, 3, 4, 9-12, 14-17, 30, 32-33, 38-41, and 43-46 of the instant application are *prima facie* obvious over claims 1-4, 6-15, 29, and 30 of copending '653.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.'

Response to Arguments

Applicant's arguments filed February 6, 2006 have been fully considered but they are not persuasive. Addressing Applicant's traversal of the rejection under 35 U.S.C. § 112, 2nd paragraph for the use of the term "bisbenzoazolyl derivatives," Applicant argues that the intended meaning of "bisbenzoazolyl derivatives" is well known in the patent literature and that the use of "derivatives" to generically refer to known variants of a chemical compound is accepted. The Examiner respectfully disagrees. The term derivative is indefinite because its metes and bounds are only limited by the imagination of a person of ordinary skill in the art. For example, one skilled in the chemical arts could conceive of a near limitless number of compounds resulting from the chemical manipulation of a bisbenzoazolyl-containing molecule. Therefore, it would be unclear to a person of ordinary skill in the art, which compounds Applicant intended to be within the scope of the meaning of the term "bisbenzoazolyl derivatives." The inclusion of one or more representative examples of what Applicant intended by the term "bisbenzoazolyl derivatives" would ameliorate this term's ambiguous meaning.

Turning to the rejections described above under 35 U.S. C. §103(a) and on pages 8-14 of the previous office action, Applicant argues that the prior art references relied upon in these rejections lack the teaching of the use of porous silica particles in an emulsion composition. The Examiner respectfully disagrees. Firstly, it is noted that Iijima teaches compositions comprising surfactants, including "self-emulsion type glycerin monostearate" for enhancing the dispersion performance of the inorganic fine particles (column 12, lines 60-64 and column 13, lines 40-42). It would have been obvious to a person of ordinary skill in the art that the presence of "self-emulsion type" surfactants would result in an emulsion formulation, as the name of said

Art Unit: 1616

surfactants suggests. Notwithstanding this, all the secondary references relied upon in combination with Iijima teach compositions that may be in the form of emulsions. See for example, Fankhauser, paragraph [0250], Torgerson (col. 15, lines 50-61), and Candau (col. 11, lines 1-10). Regarding the Applicant's assertion that the prior references do not teach porous spherical microparticles, the Examiner respectfully disagrees. Iijima clearly teaches "nearly spherical" porous inorganic particles, including silica (See, for example, the abstract and claims 9-10). It would have been apparent to a person of ordinary skill in the art that "nearly spherical" porous silica particles are obvious over spherical porous silica particles, as recited by the Applicant.

In response to applicant's argument that the prior art references set forth in the previous office action failed to disclose or suggest the inclusion of spherical porous silica microparticles to unexpectedly increase the composition SPF, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). As set forth in the previous office action, it would have been obvious to a person of ordinary skill in the prior art at the time of the instant invention to combine the teachings of Iijima with the teachings of Fankhauser, or Torgerson, and/or Candau, because Iijima's porous inorganic particles carry a chemical, which may include an ultraviolet blocker (i.e. UV blocker/sunscreen), antioxidant, etc.). Fankhauser teaches compositions comprising UV filters (i.e. UV blockers/sunscreens) and silica particles; Torgerson teaches skin care compositions (i.e. a cosmetic composition) comprising sun-screening agents, including silicon dioxide (i.e. silica); and Candau also teaches artificial tanning

Art Unit: 1616

compositions (i.e. a cosmetic composition) comprising spherical silica microparticles as fillers as well as a tanning agent. Therefore, all the prior art references alone and/or in combination teach compositions comprising silica particles in the form of emulsions (implicitly in the case of Iijima and explicitly with regards to Fankhauser, Torgerson, and Candau) and the motivation for combination springs forth from the shared features of the compositions taught and the overlapping field of endeavor.

Other Matter

It has been noted that the chemical compounds recited as UV-screening agents in claims 13 and 42 are all capitalized. Chemical names are not proper nouns and should only be capitalized when they occur as the first word in a sentence. Appropriate correction is required.

Conclusion

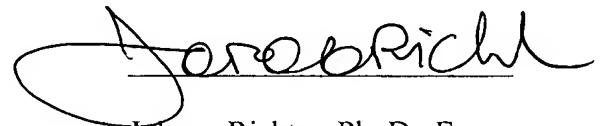
Claims 1, 3-27, 29-30, 32-55, 57-58 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Alstrum-Acevedo whose telephone number is (571) 272-5548. The examiner can normally be reached on M-F, 9:00-6:30, with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Johann R. Richter can be reached on (571) 272-0664. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Johann Richter", with a large, stylized loop at the beginning.

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